

The opinion in support of the decision being entered today was not written for publication and is
not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

FEB 23 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: JOHN JOSEPH MASCavage III,
MARGARET MORGAN and ROBERT EDWIN DRAVENSTOTT

Application No. 09/991,379

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on January 13, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

INFORMATION DISCLOSURE STATEMENT

Appellant filed an Information Disclosure Statement (IDS) dated July 18, 2005. There is no indication on the record that the Information Disclosure Statement was considered by the Examiner and the related Form 1449 needs to be signed. A written communication notifying appellant of the Examiner's consideration is required.

APPEAL BRIEF

Further, the file indicated that on January 18, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, a review of the Appeal Brief reveals that it is not in compliance with the new rules under 37 CFR § 41.37(c), which states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section.

A review of the appellant's Supplemental Appeal Brief reveals that the following required appendices are missing:

37 CFR § 41.37(c)(1)(ix), which is identified in the new rules as:

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

Application No. 09/991,379

and

37 CFR § 41.37(c)(1)(x), which is identified in the rules as:

(x) ***Related proceedings appendix.*** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

Section 37 CFR § 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

It is required that a substitute Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

It should be noted that the required filing fee for the Appeal Brief was authorized, but not charged against the deposit account.

EXAMINER'S ANSWER

On May 31, 2005, an Examiner's Answer, was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the headings as required under 37 CFR § 41.37(c).

Accordingly, it is

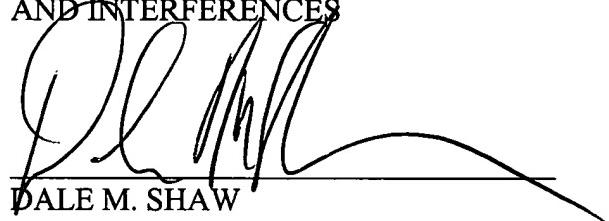
ORDERED that the application is returned to the examiner to:

- 1) consideration and proper written response to the Information Disclosure Statement filed July 18, 2005;
- 2) the required Appeal Brief fee should be charged to the Deposit Account (No.20-1430) as authorized by appellant (see Appeal Brief, p.9);
- 3) hold the Appeal Brief filed on January 18, 2005, defective;
- 4) to notify appellants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 5) to vacate the Examiner's Answer mailed May 31, 2005, to consider the substitute Appeal Brief; and submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and
- 6) for any further action as may be appropriate.

Application No. 09/991,379

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e. abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES


DALE M. SHAW
Program and Resource Administrator
(571) 272-9797

DMS/dpv

Application No. 09/991,379

TOWSEND AND TOWSEND AND CREW, LLP
Two Embarcadero Center
Eight Floor
San Francisco, CA 94111-3834